REMARKS

This amendment is responsive to the Office Action dated July 25, 2006, the response to which is due October 25, 2006. In the application claims 1 - 18 are pending, and each claim stands rejected in view of Applicant's previous patent. In this amendment claims 1 - 18 have been canceled and replaced with new claims 19 - 22. Applicant has carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the new claims in view of the remarks presented below.

Rejections under 35 U.S.C. § 103

In order to reject a claim for obviousness, three criteria must be met. To establish a *prima facie* case of obviousness, the Office Action must achieve three objectives: (1) The Office Action must demonstrate suggestion or motivation, either in the references themselves or in the prior art, to modify the reference as suggested by the Office Action or to combine the references as suggested by the Office Action; (2) The Office Action must establish that the proposed combination has a reasonable expectation of success; and (3) The Office Action must demonstrate that each claim limitation in each claim is taught or suggested in the cited references. M.P.E.P. §706.02(j).

Claim 19

A crane game comprising:

a crane maneuverable within a target bin by a player and including acquisition means for capturing a target therein;

a plurality of targets disposed within the target bin, each said target having a value associated therewith;

a **variable width inclined slot located above said target bin** for establishing a diameter of a captured target, the variable width inclined slot comprising a plurality of

stations longitudinally disposed along the slot and each station associated with a portion of the slot having a constant width, and wherein a width of the slot at each station increases as an elevation of the inclined slot decreases such that **a target moving down the inclined slot will fall** through the slot when the width of the slot exceeds the diameter of the target, **back into the target bin**;

a target conveyor for delivering a captured target to said variable width slot;

a sensor for optically sensing when a target passes through a portion of said slot, and **for sensing which portion of said slot said target passes through**, said sensor capable of **communicating a different signal** depending upon which slot the target passes through; and

a ticket dispensing mechanism for receiving said signal from said sensor and dispensing redeemable tickets in an amount determined by a signal received corresponding to a particular sized target.

New Claim 19 includes features and limitations that are not found in the prior art, and there is no teaching or motivation to modify the cited references to achieve the benefits found therein. In particular, the Office Action found that it would have been obvious to combine the teachings of Allison, U.S. Patent Application Publication No. 2003/0100255 with Shoemaker Jr., U.S. Patent No. 5,855,374. Allison is a coin sorter for a motor vehicle, where coins fall through a slot into a hopper. Certainly there is nothing in the Shoemaker Jr. disclosure that would suggest the use of a coin sorter be incorporated into the teachings, since Shoemaker primarily deals with prizes being distributed directly to the player. There is nothing in Shoemaker to suggest that a size of a target be used to determine the game's result, or that size could be measured directly as opposed to indirectly. Further, there is nothing in Shoemaker or Allison that compel one to solve the problem of returning the targets directly back into the bin, which is

accomplished by the use of the progressive slot above the playing field. Neither Allison nor Shoemaker Jr. address this problem, further distinguishing this feature from the cited art.

The Office Action further asserts that Kelly et al., U.S. Patent No. 5,704,612 teaches sensors and thus it would have been obvious to incorporate sensors in the proposed combination of Shoemaker Jr. plus Allison to "allow the game machine to easily separate the different size objects." [Office Action, p. 4]. Respectfully, there is no teaching except the applicant's disclosure for separating targets into different sizes, so it is difficult to see how it would have been obvious to combine the teachings of Kelly et al. for the stated reasons. Again, Shoemaker is primarily concerned with picking up prizes and delivering them to a prize receptacle from which the player can extract the prize, and the teaching must be viewed from the whole perspective and not a single line from the entire specification. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000). "The absence of such a suggestion to combine is *dispositive* in an obviousness determination." *Gambro Lundia AB v. Vaxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997). Here, there is simply no teaching or suggestion apart from the applicant's own disclosure to combine the unrelated art collected by the Office Action and combine them in the manner proposed therein.

Other features of Claim 19 are also not addressed by the cited art, including the sensor sending different signals to the ticket dispenser depending upon the size of the target. Accordingly, it is respectfully submitted that new Claim 19 is in condition for allowance.

Claims 20 - 22 include color coding, a rotating playing field within the target bin, and allocating tickets by the size of the targets. Because they depend from Claim 19

which has been shown to be allowable, Claims 20 - 22 are separably allowable on this basis as well. Accordingly, Applicant respectfully submits that the application is now in condition for allowance.

If the examiner believes that a telephone interview will further the prosecution of this case, the examiner is kindly invited to contact the undersigned at the number below.

If any fees are due, please charge our Deposit Account No. 21-0800.

Respectfully submitted,

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